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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/667,909
Filing Date: September 22, 2003
Appellant(s): MURPHY, RICHARD F.

Richard F. Murphy
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/26/2007 appealing from the Office action mailed 5/18/2007

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5330521	COHEN	07-1994
US2001/0027310	PARSI ET AL.	10-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 41 is rejected under 35 U.S.C. 102(b) as being anticipated by Cohen (5,330,521). Cohen discloses a low resistance implantable electrical lead.

Regarding claim 41, Cohen discloses a medical device (12) (Figure 4) including a reinforcing member (42) providing one or more filaments (42) adapted and configured to be made into the reinforcing member for the medical device, the one or more filaments including a metallic surface (col 8, ln 20-30) having an initial surface area, treating at least the portion of the surface (col 9, ln 30-45) to provide a final surface area that is greater than the initial surface area, and creating the reinforcing member using the one or more metallic filaments and incorporating the member into a medical device (12) (Figures 1-7, cols 1-3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 41-56 are rejected under 35 U.S.C 103(a) as being unpatentable over Parsi et al. (US2001/0027310) in view of Cohen (5,330,521). Parsi et al. discloses a guide catheter with a lubricous inner liner.

Regarding claims 41-56, Parsi et al. discloses guide catheter (11) with an inner liner and the device being a multi-material layered composite structure. Parsi et al. discloses a catheter comprising a braided (14) metallic filament-reinforcing member (30, [0034]), an inner (16) and outer surface (12) with a lumen extending there through (13). The outer layer and inner layer of the catheter are composed of polymeric materials ([0028]) connected to the metal reinforcing element (Figures 1-7, [0002-0013]). Parsi et al. meets the claim limitations as described above but does not include a metallic member that is etched to provide a difference in surface area as claimed.

However, Cohen teaches a low resistance implantable electrical lead cable.

Regarding claims 41-56, Cohen teaches a medical device (Figure 2) with a polymeric outer layer outer layer (26, 43), a reinforcement metal filament (22, 42), and a conductive coating layer. Cohen discloses that the metal reinforcement core (22, 42) is chemically etched before the application of a subsequent material layer (col 6, ln 35-65, col 9, ln 30-45) (Figures 3-4).

At the time of the invention, it would have been obvious to use the teachings of Cohen to etch the metal filament of Parsi et al. because it is well known that the etching

can be used to clean the material before use and is used to increase adhesion between layers and different materials of a medical device. The references are analogous in the medical device art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Cohen (col 6, ln 50-70).

(10) Response to Argument

Applicant's argument is directed towards the rejection under 35 U.S.C 102(b) as being anticipated by Cohen (5,330,521) and the 103(a) rejection as being unpatentable over Parsi et al. (US2001/0027310) in view of Cohen (5,330,521). Applicant argues the Cohen reference does not disclose **treating at least the portion of the surface of the one or more metallic filaments to provide a final surface area that is greater than the initial surface are.** Applicant argues that the Cohen reference mentions etching to clean oxides off the surface to promote electrical continuity and promote adhesion. This does not necessarily increase surface area and that etching is merely a chemical removal process "like sanding a piece of wood". Examiner asserts that even if the Cohen reference is decreasing the surface area of the reinforcing member, the end result of the above mentioned etching process is expected to be a reinforcing member that has surface which not completely smooth; which is the exact result achieved by the claimed process steps argued by Applicant.

It is Examiner's position that the Cohen reference discloses the claim limitations of treating at least the portion of the surface of the one or more metallic filaments to provide a final surface area that is greater than the initial surface area. The Examiner

considers the limitation as a product by process limitation and concurrent with that analysis the reinforced metallic member of the final product created by the claimed process has no structural difference from the reinforced metallic member of Cohen. The Cohen reference discloses a medical device with a reinforcing member that is etched by an acid chemical etching process (col 6, ln 50-65). An acid etching process operates by molecular "pitting" i.e. removed pieces of material from the surface of the material. This is concurrent with Applicant's own specification in which Applicant discloses surface treatments of which one can be a chemical etching process; however, Applicant argues that this would not provide the required surface roughness claimed. Applicant's claims only necessitate a surface that is not completely smooth, not specifically whether this surface is achieved by increasing the surface area of the reinforced metallic member or decreasing the surface area of the reinforced metallic member since there is no structural difference in the resultant product.

Examiner asserts that the Cohen reference meets the product by process claim limitation and that the resulting product of Cohen has a reinforcement metallic member surface that is not completely smooth and therefore there is no structural difference between the product of Cohen and the product of the present claims; therefore the prior art of record teaches all elements as claimed and these elements satisfy all structural, functional, operational, and spatial limitations currently in the claims.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Christopher Koharski

/Christopher D Koharski/

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